

**REMARKS**

While not acquiescing to any ground of rejection, but merely to expedite prosecution, claim 1 is amended to incorporate the subject matter of claims 6 and 9, while claims 6, 7 and 9 are canceled without prejudice.

The amended claim results in a reduced number of claims presented since claims 6, 7 and 9 are now canceled, does not introduce any new issues since the amended claim finds basis in the claims heretofore considered by the Examiner, and reduces, if not eliminates, all issues.

Amended independent claim 1 is directed to a thin-film coated toner having a combination of elements, including a powder toner, with a softening temperature ranging from 50-150°C, a surface of the powder toner being coated substantially continuously with the thin film comprising a urea-base thermosetting resin, wherein the powder toner is a ground toner and an average film thickness of the thin film is 0.005 to 1µm, the urea-base resin is formed by resinifying a urea-base resin precursor mixture consisting essentially of at least either one of a urea and a urea derivative and at least either one of a formaldehyde and formaldehyde derivative on the surface of the powder toner, while avoiding fusing the powder toner, and the toner is defined by a true sphericity (DSF) according to the following formula I is 0.85 or more:  $DSF = m/M$  (I) in which  $m$  represents a minimum diameter of a projection drawing of the toner and  $M$  represents a maximum diameter of the projection drawing of the same.

Applicants traverse and request reconsideration of the rejection of former claims 1 and 7 over Imai and Adachi and submit this rejection is mooted by the amendments presented. Applicants do not acquiesce in the reasoning set forth in the Office Action, page 2 bridging to page 3.

Applicants traverse and request reconsideration of the rejection of former claim 1 and claim 6 over Imai in view of Adachi in view of Kohri and submit this rejection is mooted by the amendments presented. Applicants do not acquiesce in the reasoning set forth in the Office Action, page 3.

Applicants traverse and request reconsideration of the rejection of former claim 8 over Imai in view of Adachi in view of Serizawa and submit this rejection is mooted by the previously filed

amendment. None-the-less for the sake of completeness, Applicants do not acquiesce in the reasoning set forth in the Office Action, page 4.

Applicants traverse and request reconsideration of the rejection of former claim 9 over Imai in view of Adachi in view of Nakamura and submit this rejection is mooted by the amendments presented. Applicants do not acquiesce in the reasoning set forth in the Office Action, page 4 bridging to page 5.

As to amended claim 1, it is incompatible with the references of record and Applicants courteously solicit favorable reconsideration. The Office Action cannot support an obviousness rejection of claim 1 by simply finding various elements in separate references. As the Supreme Court recently stated, “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1717, 1741 (2006). *KSR* further states:

[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in a way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.

*Id.* In this regard, the prior art references are to be viewed as they would have been viewed by one of ordinary skill. *Kimberly-Clark v. Johnson & Johnson*, 745 F.2d 1437, 1454, 223 USPQ 603, 614 (Fed.Cir. 1984); *In re Mercier*, 515 F.2d 1161, 1165, 185 USPQ 774, 778 (CCPA 1975). “It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” *In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965).

For example, claim 1 recites as to sphericity that the “true sphericity (DSF) according to the following formula  $I$  is 0.85 or more:  $DSF = m/M$  ( $I$ ) in which  $m$  represents a minimum diameter of a projection drawing of the toner and  $M$  represents a maximum diameter of the projection drawing of the same.” The film coated toner is not taught by the references of record.

The primary references Imai and Adachi do not teach or suggest the invention defined by claim 1. For instance, “Imai and Adachi also do not disclose what the desired thickness is” (Office Action, page 3) and “Imai and Adachi fail to teach the true sphericity of the toner.” Office Action, page 4 (emphasis added).

The secondary references to Kohri and Nakamura are inconsistent with each other, and therefore would not have suggested the claimed invention. Kohri is the antithesis of Nakamura as to true sphericity, and it would be improper to choose only so much of either reference as might support a rejection to the exclusion of contrary teachings in the cited references.

On the one hand, Kohri concerns a capsule toner (col. 3, lines 7-12) and has a shape factor (SF1) defined by a formula (col. 3, line 15) which “expresses the distortion of particle caused by the difference between the long and short diameters” (col. 3, lines 47-49). A perfect sphere has an SF1 of 100, but Kohri requires a SF1 value of 120 through 180, preferably 130 through 180 (col. 3, lines 51-53), and states that less than 120 “preferable characteristics for charging and cleaning cannot be obtained.” In other words, Kohri teaches away from true sphericity, and would appear to teach away from the characteristic defined in claim 1.

On the other hand, Nakamura refers to a latent image-developing toner produced by the wet granulation method, characterized by a shape coefficient (S) that “is an index showing a overall shape of toner particle and means that the closer the value to 100, the closer the toner particle shape in the projected image to true sphericity” (col. 3, lines 19-22). However, Nakamura states that if the toner is spherical the toner does not have irregularities on its surface so that a place for moisture selectively absorbs is lost and the moisture instead wicks between toner particles, whereby “toner particles are likely to be prevented from moving so that electrification-build-up properties of toner worsen and an electrification -environmental stability also worsens” (col. 4, lines 9-13). Nakamura therefore states (S) is preferably from 103 to 120.

As mentioned above, Kohri expressly teaches a measure of sphericity less than 120 means “preferable characteristics for charging and cleaning cannot be obtained” (col. 3, lines 53-55).

Therefore, even if the Kohri mention of particle sizes was apposite, which is not conceded, the Kohri reference teaches against the sphericity numbers apparently relied upon in the rejection of

former claim 9. It would be improper to pick and choose from amongst inconsistent teachings to reject claim 1.

Accordingly, Applicants respectfully submit that amended independent claim 1, is allowable, and prompt passage to issue is respectfully requested.

To the extent necessary during prosecution, Applicants hereby request any required extension of time not otherwise requested and hereby authorize the Commissioner to charge any required fee not intentionally omitted, including application processing, extension, extra claims, statutory disclaimer, issue, and publication fees, to Deposit Account No. 06-1135 with respect to Order No. 7398-84282.

Respectfully submitted,

**FITCH, EVEN, TABIN & FLANNERY**

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